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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,436	07/11/2003	Yuan-Ching P. Chiang	PC10865B	3213

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EXAMINER

ANDERSON, REBECCA L

ART UNIT PAPER NUMBER

1626

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/617,436	CHIANG, YUAN-CHING P.	
Examiner	Art Unit		
Rebecca L Anderson	1626		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 19 August 2004.

2a)  This action is **FINAL**.                                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-6, 18, 26 and 27 is/are pending in the application.  
4a) Of the above claim(s) 26 and 27 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) 1-6 and 18 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/03/03.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

## **DETAILED ACTION**

Claims 1-6, 18, 26 and 27. Claims 1-6 and 18 are objected and claims 26 and 27 are withdrawn from consideration as being for non-elected subject matter.

### ***Election/Restrictions***

Applicant's election of Group I, claims 1-6 and 18 and the further election of the product of Example 6, 2-[3,5-dichloro-4-(4-hydroxy-3-isopropyl-phenoxy)-benzyl]-[1,2,4-oxadizolidine-3,5-dione, in the reply filed on 19 August 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

As stated on pages 3 and 4 of the restriction requirement, the election of Group I, claims 1-6 and 18 and the further election of the product of Example 6 has resulted in the following elected invention for search and examination:

**The elected invention for search and examination is the products of the formula (I) wherein:**

**W** is oxygen, sulfur, -SO, -S(O)2, -Ch2-, CF2-, -CHF-, -C(O)-, -CH(OH)-, -NRa, or -C(=CH2)-;

**R1, R2, R3, and R6** each independently hydrogen, halogen, -(C1-C8)alkyl, CF3, -OCF3, -O(C1-C8)alkyl, or CN;

**R4** is hydrogen, -(C1-C12)alkyl substituted with zero to three substituents independently selected from Group V, -(C2-C12)alkenyl, -(C2-C12)alkynyl, halogen, -

CN, -ORb, -SRc, -S(O)2Rc, aryl, -(C3-C10)cycloalkyl, -S(O)2NRcRd, -C(O)NR3Rd, -C(O)ORc, -NRaC(O)Rd, -NRaC(O)NRcRd, -NRaS(O)2Rd, or -C(O)Rc; or

**R3** and **R4** are taken together along with the carbon atoms to which they are attached to form a carbocyclic ring of formula -(CH<sub>2</sub>)<sub>l</sub>-; l is 3, 4, 5, or 6, wherein the carbocyclic ring is substituted with zero to four substituents independently selected from -(C1-C4)alkyl, -ORb, oxo, -CN, phenyl, or -NRaRg;

**R5** is hydroxy, -O(C1-C6)alkyl, -OC(O)Rf, fluorine, or -C(O)ORc;

**Ra** for each occurrence is independently hydrogen, or -(C1-C6)alkyl substituted with zero or one -(C3-C6)cycloalkyl or methoxy;

**Rb** for each occurrence is independently hydrogen, -(C1-C12)alkyl substituted with zero to three substituents independently selected from Group V, aryl, -(C3-C10)cycloalkyl, -C(O)NRcRd, or -C(O)Rf;

**Rc** and **Rd** for each occurrence are each independently hydrogen, -(C1-C12)alkyl substituted with zero to three substituents independently selected from Group VI, -(C2-C12)alkenyl, -(C2-C12)alkynyl, aryl, or -(C3-C10)cycloalkyl;

Provided that when R4 is the moiety -SRc, -S(O)R3, or -S(O)2Rc, Rc is other than hydrogen;

**Rc** for each occurrence is hydrogen, -CN, -(C1-C10)alkyl substituted with zero to three substituents independently selected from Group V, -(C2-C10)alkenyl, -(C2-C10)alkoxy, -(C3-C10)cycloalkyl, aryl, -C(O)Rf, -C(O)ORf, -C(O)NRaRf, or -S(O)2Rf;

**Rf** for each occurrence is independently  $-(C_1-C_{10})alkyl$  substituted with zero to three substituents independently selected from Group VI,  $-(C_2-C_{12})alkenyl$ ,  $-(C_2-C_{10})alkynyl$ ,  $-(C_3-C_{10})cycloalkyl$  or aryl;

**Rg** for each occurrence is independently hydrogen,  $-(C_1-C_6)alkyl$ ,  $-(C_2-C_6)alkenyl$ , aryl- $C(O)Rf$ ,  $-C(O)ORf$ ,  $-C(O)NRaRf$ ,  $-S(O)2Rf$ , or  $-(C_3-C_8)cycloalkyl$ ;

**Group V** is halogen,  $-CF_3$ ,  $-OCF_3$ ,  $-OH$ , oxo,  $-(C_1-C_6)alkoxy$ ,  $-CN$ , aryl,  $-(C_3-C_{10})cycloalkyl$ ,  $-SRf$ ,  $-S(O)Rf$ ,  $-S(O)2Rf$ ,  $-S(O)2NRaRf$ ,  $-NRaRg$ , or  $-C(O)NRaRf$ ;

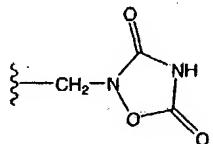
**Group VI** is halogen, hydroxy, oxo,  $-(C_1-C_6)alkoxy$ , aryl,  $-(C_3-C_8)cycloalkyl$ ,  $-CN$ , or  $-OCF_3$ ;

Provided that when  $R_4$  is  $-(C_1-C_{12})alkyl$  substituted with zero to three substituents independently selected from Group V, wherein said Group V substituent is oxo, said oxo group is substituted on a carbon atom other than the C1 carbon atom in  $-(C_1-C_{12})alkyl$ ;

**Aryl** for each occurrence is independently phenyl or naphthyl substituted with zero to four substituents independently selected from halogen,  $-(C_1-C_6)alkyl$ ,  $-CN$ ,  $-SRf$ ,  $-S(O)Rf$ ,  $-S(O)2Rf$ ,  $-(C_3-C_6)cycloalkyl$ ,  $-S(O)2NRaRf$ ,  $-NRaRg$ ,  $-C(O)NRaRf$ ,  $-ORb$ , -perfluoro- $(C_1-C_4)alkyl$ , or  $-COORf$ ;

Provided that when said substituents(s) on aryl are  $-SRf$ ,  $-S(O)Rf$ ,  $-S(O)2Rf$ ,  $-S(O)2NRaRf$ ,  $-NRaRg$ ,  $-C(O)NRaRf$ ,  $-ORb$ , or  $-COORf$ , said substituents  $Rb$ ,  $Rf$ , and  $Rg$ , are other than aryl;

**X** is



The remaining subject matter of claims 1-6 and 18 that is not drawn to the above elected invention and the subject matter of claims 26 and 27 stands withdrawn under 37 CFR 1.142(b) as being for non-elected subject matter. The remaining compounds which are not within the elected invention, which are independent and distinct from the elected invention and do not have unity with the elected compound and are therefore withdrawn by means of a restriction requirement within the claims are, for example, the compounds of the formula I wherein R4 is heteroaryl, heterocycloalkyl; or R3 and R4 are taken together along with the carbon atoms to which they are attached to form a heterocyclic ring; R4 and R5 are taken together along with the carbon atoms to which they are attached to form a heterocyclic ring; Rb is substituted with heteroaryl or heterocycloalkyl; Rc and Rd are substituted with heteroaryl or heterocycloalkyl; Rc and Rd are taken together along with atom(s) to which they are attached to form a 3-10 membered heterocyclic ring; Re is substituted with heteroaryl; Rf is substituted with heteroaryl or heterocycloalkyl; Group V is heteroaryl, or heterocycloalkyl; Group VI is heteroaryl or heterocycloalkyl and X is a thiazole or a triazole, etc..

The above mentioned withdrawn compounds which are withdrawn from consideration as being for nonelected subject matter differ materially in structure and composition from the compounds of the elected invention. The withdrawn compounds differ from those of the elected invention, such as, for example, by triazole, thiazolyl, furyl, thienyl, morpholinyl, piperazinyl, pyrrolyl, etc. which are chemically recognized to differ in structure and function. This recognized chemical diversity of the compounds can be seen by the various classification of these functional groups in the U.S.

classification system, i.e. class 548 subclass 262.2+ (triazole), class 548 subclass 146+ (thiazolyl), class 549 subclass 200+ (furyl), class 549 subclass 29+ (thienyl), class 548 subclass 106+ (morpholinyl), class 544 subclass 358+ (piperazinyl) and class 548 subclasss (400)+ pyrrolyl, etc. Therefore, again, the compounds which are withdrawn from consideration as being for non-elected subject matter differ materially in structure and composition and have been restricted properly as a reference which anticipated but the elected subject matter would not even render obvious the non-elected subject matter.

These withdrawn compounds are independent and distinct from the elected invention and do not have unity with the species elected and are therefor withdrawn by means of a restriction requirement within the claims.

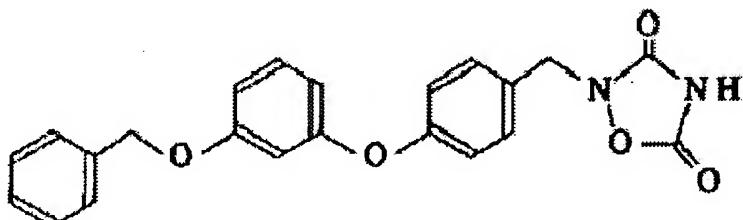
The requirement is still deemed proper.

#### ***Claim Objections***

Claims 1-6 and 18 are objected to as containing non-elected subject matter. Claims 1-6 and 18 presented drawn solely to the elected invention as identified supra would appear allowable over the prior art of record.

The closest prior art of record is JP 8-59638.

JP 8-59638 discloses on page 24, the compound 6:



which corresponds to applicants instant elected invention of of the formual (I)wherein X is the 1,2,4-oxadiazolidine-3,5-dione, R1 and R2 are hydrogen, W is oxygen, R3 and R6 are hydrogen and R4 is Orb wherein Rb is alkyl substituted with aryl, differs from the instant elected invention by the position equivalent to applicants R5. The prior art has the position equivalent to R5 as hydrogen, however, applicants instant elected invention requires R5 to be hydroxy, -O(C1-C6)alkyl, -OC(O)Rf, fluorine or -C(O)ORc. The prior art neither teaches nor provides motivation to prepare applicants instant elected invention wherein R5 is hydroxy, -O(C1-C6)alkyl, -OC(O)Rf, fluorine or -C(O)ORc

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday 5:30AM to 2:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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